

PATENT
Customer No. 22,852
Attorney Docket No. 02734.0492-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Galyn A. SCHULZ) Group Art Unit: 1731
Application No.: 10/775,252) Examiner: Eric J. HUG
Filed: February 11, 2004)
For: APPARATUS AND METHOD FOR) Confirmation No.: 1102
DEGRADING A WEB IN THE MACHINE)
DIRECTION WHILE PRESERVING)
CROSS-MACHINE DIRECTION)
STRENGTH)

MAIL STOP AMENDMENT

VIA EFS-Web

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

This paper responds to the Office Action dated August 24, 2006 ("Restriction Requirement"), the period for response having been extended to October 24, 2006, with the Petition for Extension of Time of one (1) month and fee payment filed concurrently herewith. Claims 1-33 are currently pending in this application. The Office has required restriction under 35 U.S.C. § 121 to one of the following three claim groups:

Group I - Claims 17-27, drawn to a method for embossing a web, classified in class 162, subclass 117;

Group II - Claims 1-10 and 28-33, drawn to an embossing system, classified in class 162, subclass 362; and,

Group III - Claims 11-16, drawn to an embossed web product,
classified in class 428, subclass 152.

Applicant provisionally elects, with traverse, to prosecute the subject matter presently recited by Group III, claims 11-16. Applicant respectfully traverses the restriction requirement between Groups I, II, and III because the subject matter within those groups overlaps to such an extent that examination of all the claims would not present a serious burden on the Examiner. See MPEP § 803 ("There must be a serious burden on the examiner if restriction is required.").

Although the Examiner believes that the product of Group III may be made by a materially different process and apparatus, such as by passing the web through an apparatus comprising successive pairs of embossing rolls (see Restriction Requirement at page 3), Applicant asserts that examination of Groups I, II, and III would not present a serious burden on the Examiner. For example, regardless of the different classifications and claim types, all three groups involve embossments aligned in the cross-machine direction. As such, a proper search for the subject matter of Group III—directed to an embossed web product having cross-machine direction embossments—would at least partially overlap with a proper search for the subject matter of Group II (an embossing system having cross-machine direction embossments) and Group I (a method for embossing a web with cross-machine direction embossments). That overlap between the searches highlights the lack of a serious burden on the Office to consider both groups of claims in this application; therefore, Applicant respectfully requests that the restriction requirement be withdrawn.

Applicant has provisionally elected, with traverse, to prosecute the subject matter of Group III, as currently embodied in claims 11-16. For the reasons stated above, however, Applicant asks that the restriction requirement be withdrawn and that all pending claims be considered during the examination of this application.

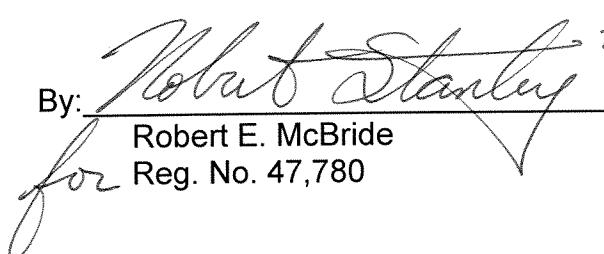
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 24, 2006

By:


Robert E. McBride
Reg. No. 47,780